


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q77644	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/669,653	September 25, 2003	
	First Named Inventor		
	Hiroaki NAKAMURA		
	Art Unit	Examiner	
	2624	Jeffrey S. Smith	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>60,645</u></p> <div style="text-align: right;">  Signature </div> <div style="text-align: right;"> <u>Theodore C. Shih</u> Typed or printed name </div> <div style="text-align: right;"> <u>(202) 293-7060</u> Telephone number </div> <div style="text-align: right;"> <u>August 22, 2008</u> Date </div>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q77644

Hiroaki NAKAMURA, et al.

Appln. No.: 10/669,653

Group Art Unit: 2624

Confirmation No.: 5576

Examiner: Jeffrey S. Smith

Filed: September 25, 2003

For: IMAGE RECORDING APPARATUS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated February 22, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue. As of the Advisory Action mailed August 22, 2008, claims 6, 10, and 11 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph. Claims 1-3 stand rejected under 35 U.S.C. 102(e) as being allegedly anticipated by White et al. (U.S. 7,035,462; hereinafter "White"). Claim 4 stands rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White. Claims 5-8 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over White in view of Shiota et al. (U.S. 6,345,998; hereinafter "Shiota"). Claims 9-13 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shiota in view of White.

Claim Rejections - 35 U.S.C. § 103

Claim 4

The Examiner has not responded to the patentability arguments regarding claim 4 set forth at pages 9 and 10 of the Amendment filed on July 21, 2008. However, MPEP §707.07(f) requires that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” In contrast to the requirements of MPEP §707.07(f), the Examiner has not responded to Applicants’ arguments that White fails to disclose:

the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print.

To the contrary, the Examiner asserts:

White discloses printing images on paper using printer 61. Column 1 of White discusses printing the uncorrected red eye photographs, which can be achieved by White in box 218 of figure 11 by selecting no red eye correction, or by simply printing the red eye photograph without performing red eye correction. Printing the red eye corrected image can be achieved by White by performing the red eye correction process of figure 11 and printing the red eye corrected version of the image. Thus, a user who prints an image with printer 61 before using the red eye correction process, then prints an image with printer 61 after using the red eye correction process, would have the original and the red eye correction photographic prints of the image.

Assuming arguendo that Kiosk 60 of White is capable of performing the functions asserted by the Examiner, such a process would be at odds with the claimed invention. The Examiner argues for the combination of elements in White, and asserts a method of implementing White to disclose the present invention. Such a combination of elements as proposed by the Examiner, however, would prevent the present invention to function as claimed in claim 4. As shown in Fig. 11 and admitted by the Examiner, either the corrected or uncorrected image is stored and printed. Such an implementation of White is counter to claim 4 as both the corrected and uncorrected images are printed. The Examiner asserts that it would be obvious to implement the decision making process of Fig. 11 twice to correspond to claim 4 because the combination is the

predictable use of printing a corrected image onto a print followed by the predictable use of printing the original image onto a print. Such an assertion, however, is based on the Examiner viewing the White reference with the benefit of hindsight vision afforded by the claimed invention. The Examiner is assuming more than just “whether the improvement is more than the predictable use of prior art elements according to their established functions.” See *KSR Int’L v. Teleflex Inc.* 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007).

White teaches printing the images one at a time. (See Fig. 11). White, however, does not teach or suggest photographic prints of both the corrected image, *and* the set of image and information or the original image. Thus, White does not disclose or teach, “the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print” of the claimed invention.

Claim 5

The Examiner has not responded to the patentability arguments regarding claim 5 set forth at pages 3 and 4 of the Amendment filed on July 21, 2008. Applicants respectfully submit that claim 5 is not anticipated by Shiota. Specifically, Shiota discloses the image handling apparatus 15 is a general purpose computer with dedicated software installed. (See col. 10, lines 53-55). FIG. 8, and the general purpose computer 15 of Shiota, however, are too general to teach the specific elements of claims 5. Further FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together in Shiota as described in claim 5 of the present invention. Finally, Shiota, only discloses transferring *processed* image data. (See col. 11, lines 1-5). As a result, Shiota does not disclose that the image handling apparatus 15 contains the proper software and hardware to “transmits the *corrected image* and *image data*” as recited in claim 5.

Claims 7 and 8

The Examiner has not responded to the patentability arguments regarding claims 7 and 8 set forth at pages 4 and 5 of the Amendment filed on July 21, 2008. Specifically, the Examiner has not responded to Applicants' arguments that Shiota does not allow for the uncorrected data processes as described by claims 7 and 8, and that one of ordinary skill in the art at the time of the presently-claimed invention would not have been motivated to combine White and Shiota as suggested by the Examiner because there is no suggestion of motivation for doing so in the references themselves or the knowledge available to one of ordinary skill in the art without resorting to impermissible hindsight.

Claims 7 and 8 describe alternative printing or data storage of corrected and original data. However, it is clear from FIG. 2, that all data stored or printed in Shiota is corrected data. Shiota discloses in FIG. 2 that all data stored or printed is processed data (corrected data). Alternatively, White teaches correcting for eye color defects but does not disclose storing an original image. (See Abstract). The Examiner asserts that, "storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota" would have been obvious "for the benefit of increasing efficiency". However, FIG. 2 of Shiota teaches that all images stored in element 6 are processed data (corrected data). Thus, Shiota does not allow for the uncorrected data (original image) processes as described by claims 7 and 8. Because of the disparity between these two references, the only possible motivation for the Examiner's proposed combination is Applicant's own disclosure, the reliance on which constitutes impermissible hindsight reconstruction under MPEP §2143 (see also *In re Vaeck*, 20 USPQ 1438 (Fed. Cir. 1991)).

Claim 9

The Examiner has not responded to the patentability arguments regarding claim 9 set forth at pages 5 and 6 of the Amendment filed on July 21, 2008. Specifically, the Examiner has not responded to Applicants' arguments that in FIG. 2 of Shiota, the image (printer path 7) and the image

and thus Shiota does not disclose or suggest “transmits the corrected image data *and* original image data *together*” as recited in the claimed invention.

The Examiner has also failed to respond to Applicants’ argument that FIG. 1 and disk 6 of Shiota fails to disclose, “a recording of corrected image data as electronic data, said image recording means for further recording one of a) the image data capable of reproducing the original image and b) the original image onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data” as recited in claim 9. To the contrary, Shiota does not allow for the uncorrected data processes as described by claims 9. Thus, Shiota does not disclose or suggest an “image data *capable of reproducing the original image*”, or “*the original image* onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data,” as recited in the claimed invention.

Conclusion

For the above reasons, Applicants submit that claim 9 is patentable over the prior art. Claim 1 is a related apparatus claim and for analogous reasons to claim 9, claim 1 is also not anticipated and should be patentable over the cited references. Accordingly, claims 2-8, and 10-13 are patentable at least by virtue of their dependencies on claims 1 and 9 respectively as well as for their additionally recited elements.

Respectfully submitted,



Theodore C. Shih
Registration No. 60,645

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: August 22, 2008